

O/0305/26

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 4052477
IN THE NAME OF 27 CATERING LTD
TO REGISTER AS A TRADE MARK**



IN CLASS 4

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 449393
BY PRIMA INDUSTRIES LIMITED**

BACKGROUND AND PLEADINGS

1. On 16 May 2024, 27 Catering Ltd (“the applicant”) applied to register the trade mark shown on the cover of this decision, in the United Kingdom, for the following goods:

Class 4: *Biofuel; Biofuels; Ethanol fuels; Ethanol [fuel]; Biomass fuel; Alcohol [fuel]; Alcohol (fuel); Fuels; Fuel; Fuel mixtures; Fuel for portable fireplaces; Fuels and illuminants; Liquid fuels.*

2. The application was accepted and was published for opposition purposes on 31 May 2024.

3. The application is opposed by Prima Industries Limited (“the opponent”). The opposition was filed on 29 August 2024 and is based upon Section 3(1)(a), Section 3(1)(b), Section 3(1)(c) and Section 3(1)(d) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application.

4. In brief, the opponent claims that the mark describes the goods, that it is not distinctive, and that it consists of signs that are customary within the trade. It requests the refusal of the applicant’s mark in its entirety and requests an award of costs in favour of the opponent.

5. The applicant filed a counterstatement denying each of the claims made by the opponent under sections 3(1)(a), 3(1)(b), 3(1)(c) and 3(1)(d) and it puts the opponent to strict proof of each of its allegations. It submits that the opposition is completely unfounded and should be rejected entirely, with the application allowed to proceed to registration in respect of all goods. The applicant also requests an award of costs be made in its favour.

6. Only the opponent filed evidence. Neither party requested a hearing; only the applicant filed written submissions in lieu of a hearing, which will be referred to as and where appropriate in my decision. This decision is taken following careful consideration of the papers on file.

7. In these proceedings, the opponent is represented by Franks & Co Limited and the applicant is represented by Squire Patton Boggs (UK) LLP.

EVIDENCE

8. The opponent filed evidence in the form of the witness statement of Dr Robert Terence Smith, dated 18 February 2025. Twenty exhibits, labelled RTS01 – RTS20, are adduced in support of the opposition. Dr Smith is a Director of the opponent, a position he has held since January 2006.

9. I will not provide a full summary of the exhibits at this point, but I will instead give a brief outline of them, grouped collectively, as appropriate:

- Exhibits RTS01 to RTS04 comprise definitions of the term “Biofuel” and examples of usage of the term in trade.
- Exhibits RTS05 to RTS09 comprise examples of UK trade marks registered in class 4 for a variety of goods, each of which includes the term “Biofuel” within the mark as a whole, alongside other words and/or device elements.
- Exhibit RTS10 comprises an example of a flame/flames being used in the branding and advertising of fuel-related products by third party Homefire Group Ltd.
- Exhibits RTS11 to RTS13 comprise examples of advertisements showing use of the term “BioFire” for the sale of biofuel products.
- Exhibit RTS14 comprises the search results returned for the term “biofire fuel” on the UK domain for the online sales platform eBay.
- Exhibit RTS16 is an index summary of the compilation of materials which Dr Smith describes as showing prior use of “Bio fire”, “Bio fuel” and “bio fire fuel” to describe fireplaces which burn bio fuel and bio fuel itself; Exhibits RTS16 to RTS19 are appendices to exhibit RTS15.
- Exhibit RTS20 comprises an example of a UK registered trade mark for the term “BIOFIRE” in relation to fireplaces and heating apparatus, as registered in class 11.

10. I will refer to the evidence in more detail, to the extent I consider necessary, later in the decision.

DECISION

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 3(1) –

12. Section 3(1) of the Act provides as follows:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

13. Section 1(1) states:

“ 1(1) In this Act “trade mark” means any sign which is capable —

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”

14. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under Section 3(1)(b): SAT.1 *SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-329/02 P at [25].

15. The relevant date for determining whether the applicant’s mark is objectionable under sections (3)(1) is the date on which the application was made, being 16 May 2024.

Section 3(1)(a)

16. Mr Geoffrey Hobbs QC, (as he then was), sitting as the Appointed Person in *AD2000 Trade Mark*, said that section 3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “not being incapable” of distinguishing.¹

¹ [1997] RPC 168.

Consequently, if I am satisfied that the mark complies with sections 3(1)(b), (c) and (d) of the Act, the 'incapable of distinguishing' objection under section 3(1)(a) is bound to fail. Alternatively, if any of the grounds under section 3(1)(b), (c) or (d) succeed, the outcome under section 3(1)(a) becomes moot. In any event, this ground of opposition fails for the reasons given by Arnold J (as he then was) in *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch):

"44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4, the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services,

capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing **any** goods or services."

(My emphasis)

17. I note that in its statement of grounds, the opponent has made a catch-all claim as to why it considers the opposed marks offend under sections 3(1) of the Act, i.e. that the sign describes the goods, is not distinctive and is customary in trade.² While points 6 to 11 of the statement are intended to address the specific claim under section 3(1)(a), it merely speaks of the descriptive nature and lack of distinctiveness of the applied-for mark, rather than addressing why it considers the mark "incapable" of being represented in the register. I do not consider that the opponent has provided evidence to show that the mark is incapable of distinguishing any goods or services.

² At points 4.

18. The section 3(1)(a) ground fails.

Section 3(1)(d)

19. I will now consider the opposition under Section 3(1)(d) of the Act.

20. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods

or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

21. In light of the above case law, the pertinent question is whether, on the relevant date (16 May 2024), the figurative mark "**biofirefuel**" (as shown on the cover page of this decision) had, based on the perception of the average consumer of the goods in the UK, "become customary in the current language or in the bona fide and established practices of the trade" to designate the goods covered by that mark.

22. In my view, the average consumer of the goods, being various forms of fuel and biofuel, will be industrial consumers, such as those from within the Transport and Heating industries. I consider it likely that the goods will also be used in the Manufacturing Industry. These consumers will have a high degree of knowledge of the goods at hand. I consider that the average UK consumer of the goods may also be the general UK public for use in home heating products, such as for domestic fires, as well as a specialist in trade, such as a third party supplier of the goods to retail or wholesale outlets, and who is likely to have a broader knowledge of the goods at hand than a member of the general public.³

23. It is the opponent's claim that each of the individual constituent elements of the mark are customary in trade to describe the goods for which the applied-for mark seeks registration. It has provided definitions of the term "Biofuel", including those sourced from the Britannica Encyclopaedia and Wikipedia (see exhibits RTS01-02), as well as examples of use of the term Biofire (exhibits RTS04, RTS11 - RTS13), and

³ See *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, paragraph 24.

further examples of the use of both artist illustrations of flames as well as photographs used in advertising and on product packaging of various biofuel related goods.

24. I do not refute the descriptive nature of the term “biofuel” for the class 4 goods at issue. Indeed, biofuels at large are included in the specification of goods for which the applicant seeks registration under the contested mark. However, it is the mark as filed, comprising the term “biofirefuel” presented in a stylised manner, alongside an artistic depiction of a flame, which I must consider.

25. Although the opponent’s evidence includes definitions and/or examples of use of the terms “biofuel” and “biofire”, as well as of depictions of a flame/flames being used in the branding and advertising of fuel-related products, I agree with the applicant that the evidence does not show that the term “biofirefuel” either solus or in conjunction with a depiction of a flame, had become customary in the current language or in the bona fide and established practices of trade at the relevant date.

26. I find nothing within the evidence which supports that the mark as filed, for the specification of class 4 goods being a variety of fuels and biofuels, had become generic/customary in trade in the UK, at the relevant date in relation to *any* of the goods applied for.⁴

27. The opposition based on Section 3(1)(d) fails.

Section 3(1)(c)

28. I will now move to consider the opposition under Section 3(1)(c) of the Act.

29. At paragraph 55 of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] E.T.M.R. 57, Case C-363/99, the Court of Justice of the European Union (“CJEU”) described section 3(1)(c) as requiring “that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in

⁴ See goods as listed under paragraph 2 of this decision.

order that they may use them when describing the same characteristics of their own goods.”

30. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that

regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of

Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

31. With consideration to the above principles, in assessing the mark under Section 3(1)(c), I keep in mind that the objective of this section is to ensure that signs which consist exclusively of elements which designate a characteristic of the goods remain free for use by other traders of those goods.

32. I note that a trade mark does not need to be in use in a descriptive manner at the time of application for it to fall foul of Section 3(1)(c): the possibility that a sign may be used descriptively in the future should also be considered.⁵

33. The contested mark comprises an artistic impression of a flame which is made up of three colours, being green, yellow and orange, alongside the combined words “biofirefuel”, presented as a single word. The word “bio” is presented in a bold black typeface, while the word “fuel” is presented in a regular black typeface, and the word “fire”, situated between the two, is presented in an orange typeface.

⁵ See *Exalation v OHIM*, Case T-85/08, paragraphs 42 – 43.

34. In its statement of grounds, the opponent claims that when considering the mark as a whole, the word/text element dominates the mark, that pictures of flames are commonly used in the industry for fuels, and that the addition of the flame logo depicts the intended purpose of the goods, to create a flame or combustion.⁶ It claims that the colours black and orange are descriptive of flames and fires and do not of themselves add distinctive character to the mark. I note the applicant's submissions that "the sign contains a highly stylised flame logo, ..., which is not descriptive of the goods covered by the Application." It continues that "The logo has an unusual, individual and complex teardrop like shape, with overlapping bands of green, orange and yellow ..." which is "... an eye-catching combination, and these features are not present in simple images of flames."⁷ I also note the applicant's submissions that the opponent's evidence shows that traders do incorporate stylised flame logos into their trade marks which are distinct from images of flames that are used to convey information not related to commercial origin, as shown in particular in exhibits RTS04, RTS10 and RTS16 of the evidence. The applicant further submits that the consumer of the goods at issue would be accustomed to the difference between pictures or simple images of flames used for descriptive purposes and highly stylised images of flames which convey the commercial origin of the goods.⁸

35. I note that in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29, Arnold J. (as he then was) held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character.⁹ In relation to the goods for which the applied for mark seeks registration, I agree that a depiction of a flame may serve to reinforce the message that the goods at issue are connected to fires, and as such is not considered to be an arbitrary inclusion. While a picture of a flame may be considered synonymous with goods such as those used to fuel fires, the device contained within the contested mark is an artistic impression of a flame as described in paragraph 33 of this decision. It is prominently placed at the forefront of the mark to the left of the word element, and cannot be said to be "a

⁶ At points 26 and 28.

⁷ Applicant's written submissions in lieu of a hearing, at [21].

⁸ *IBID.*, at [23- 24].

⁹ At [116 -117].

minor figurative embellishment". To my mind, the device is sufficiently stylised that it adds to the distinctive character of the mark as a whole.

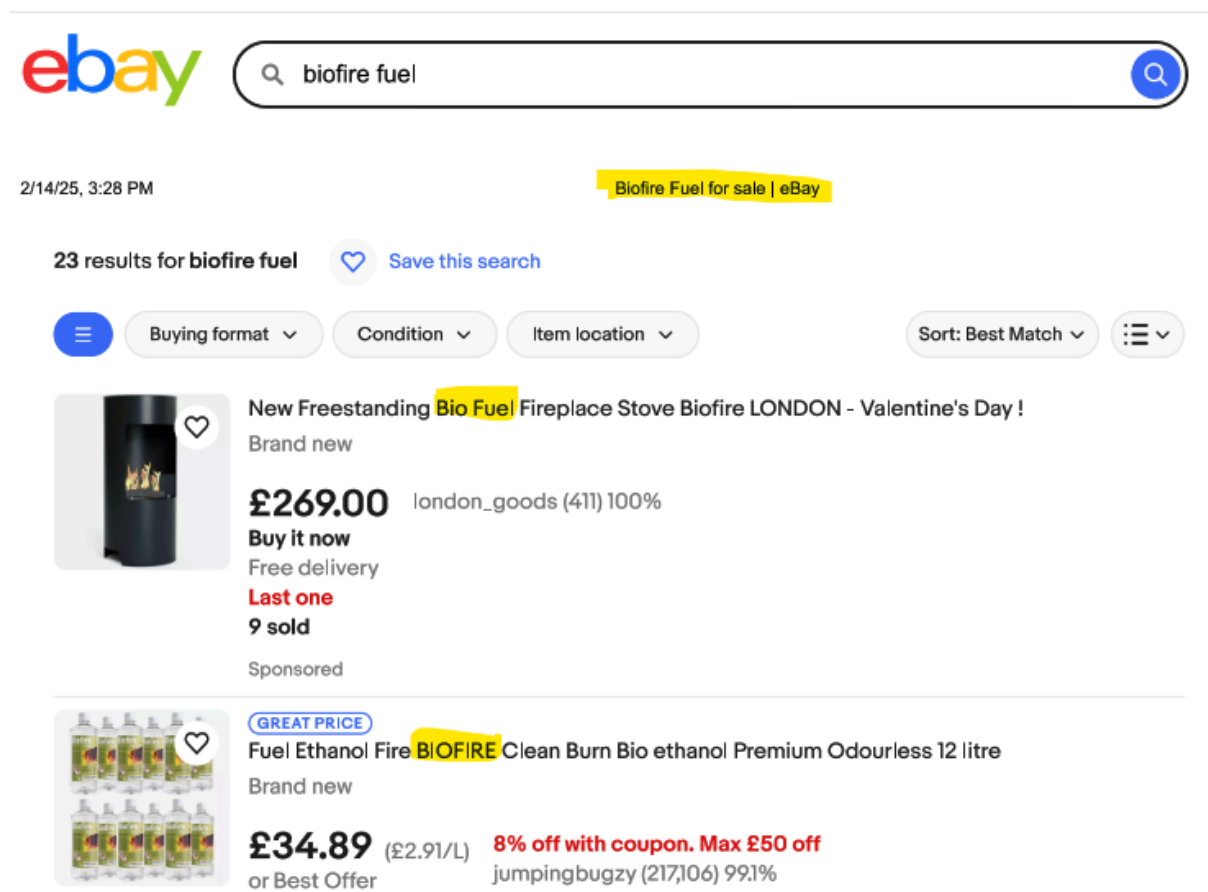
36. The word elements that make up the mark are presented in a stylised typeface which I do not consider deviates greatly from a standard typeface, in the colours and text style described in paragraph 33. The opponent's evidence as a whole focusses on the descriptive nature of the terms "biofuel" and "biofire" and the use of a flame device on the goods at issue. As mentioned earlier under the section 3(1)(d) grounds, I do not contest the descriptive nature of the term "biofuel" for the class 4 goods at issue. As well as the evidence showing the descriptive nature of the term "biofuel", the opponent has endeavoured to demonstrate through Exhibit RST04 the descriptive nature of term "Biofire". I note that the exhibit shows the term in relation to fireplaces which fall under class 11 of the Nice Classification, rather than in relation to the class 4 goods for which the mark seeks registration, and as such provides little probative value. Further, the examples of use of the term "biofire" in relation to the class 4 goods, as found in exhibits RTS11 - 13, appear to be trade mark use, with the descriptor of the goods being "bioethanol fuel":

Exhibit RTS11



Bioethanol Fuel BIOFIRE Clean Burn Bioethanol Premium Grade Odourless 12 litre

37. As submitted by the applicant, the opponent has not filed any viable evidence in relation to the actual term contained within the mark, being “biofirefuel”. Although exhibit RTS14 shows the term “biofire fuel” as entered into a search on the selling platform eBay, no results have been returned for the exact same phrase, and instead, shows references to either biofire or biofuel. I note the reference to “Biofire Fuel for sale” at the top of each page of results, however, it seems to me that this stems purely from the search term as input by the searcher, and as such does not evidence use of the words per se:



(My highlighting).

38. For the avoidance of doubt, I find no probative value to exhibits RTS15 - RTS20. Exhibit RTS15 is described at point 23 of the witness statement as an index summary of the compilation of materials showing prior use of “Bio fire”, “Bio fuel” and “bio fire fuel” to describe fireplaces which burn bio fuel and the bio fuel itself; exhibits RTS16-RTS19 are listed as Appendices 1 to 4 in exhibit RTS15. I note that Appendix 3 and Appendix 4 as contained within exhibit RTS19 comprise letters from the Directors of

two companies selling fireplaces in response to Dr Smith's request for them to provide their understanding of the term "bio fire fuel". The responses to Dr Smith's request are the opinions of the directors and do not constitute a statement of fact. As outlined in the Manual of trade marks practice at 4.8.4.4, weight can be attached to the opinion of an expert on the likelihood of confusion between opposing marks, based on experience and if it has been explained in sufficient detail so that it can be ascertained why the expert holds that opinion.¹⁰ While I consider the same to be true in relation to the 3(1)(c) grounds, in this case, it appears that the directors have been asked to comment on the combination of words only and have not been exposed to the actual sign of the application. As such, I do not find that the exhibits assist me in assessing the descriptiveness/distinctive character, or otherwise, of the contested mark and so I give no weight to the evidence provided.

39. The contested mark is a composite mark. I acknowledge that the combining of words does not necessarily provide them with a distinctive character under section 3(1)(c).¹¹ However, if the combination of descriptive elements within a mark is unusual and creates an impression that is sufficiently far removed from being simply a composite description of the goods, the trade mark may be registrable. In the case at hand, I take into account the unusual juxtaposition of the word "fire" which has been placed between the "bio" and "fuel" elements, creating a neologism which, in my view, is not naturally descriptive of the class 4 goods. I accept that some neologisms may become widely used and enter the language as a generic term, and that under section 3(1)(c), I must consider if the mark may become descriptive in the future. In my view, in the case before me, this is unlikely. While I consider the term "biofirefuel" to be allusive of goods such as biofuels intended to be used in fires, I do not find it to be descriptive of them. Even if the term were to become normal use for the goods at hand in time, I must consider the mark as presented. Given the unusual combination of device and words, presented in a variety of colours, as described above, and including the distinctiveness attributed to the artistic impression of a flame, I consider that, as outlined in *Campina Melkunie BV* cited in paragraph 38, the mark as a whole

¹⁰ See *Valucci Designs Ltd t/a Hugo Hogs v IPC Magazines Ltd* BL O/455/00, at [34-35].

¹¹ *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/0, at [39-41].

is greater than the sum of its descriptive parts, sufficient to be able to distinguish trade origin.

40. Consequently, I find that insufficient evidence has been provided to demonstrate that the applied-for mark is purely descriptive of a characteristic of those goods and that the mark would not, therefore, be recognised in the UK as designating an essential characteristic of fuels and biofuels.

41. Taking all of the above into account, I have no basis on which to find that the mark should remain free for use by other traders on any of the goods.

42. The opposition under Section 3(1)(c) fails.

Section 3(1)(b)

43. Section 3(1)(b) of the Act prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular

undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

44. In relation to the 3(1)(b) claim, in its statement of grounds, the opponent refers to the descriptive nature of both the word element of the mark (at [13]), and of the flame device (at [18]), and submits that the combination of the words and device and the stylisation/colour combination thereof do not add sufficient distinctiveness to the mark for registration.¹²

¹² At [19].

45. Earlier in this decision, I found the contested mark to be acceptable under sections 3(1)(a), 3(1)(c) and 3(1)(d) and I considered that the mark in its entirety was not directly descriptive of the goods to which the mark is to be applied.

46. I remind myself that section 3(1)(c) and section 3(1)(b) are independent grounds and have differing general interests. However, the opponent has not provided any further evidence in relation to its claims under 3(1)(b) per se. I have already found that the contested mark is not descriptive of the class 4 goods, as accepted *prima facie* at the examination stage of the application. I see nothing within the opponent's evidence to demonstrate that the mark is devoid of distinctive character in respect of the goods at issue, and I do not find there to be any logical reason why the mark as a whole would be unable to indicate trade origin to the relevant public.

47. The opposition under Section 3(1)(b) fails.

CONCLUSION

48. The opposition has failed on all grounds. Subject to any successful appeal, the application by 27 Catering Ltd may proceed to registration.

COSTS

49. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. Applying the guidance in that TPN, I consider the following to be fair:

Considering the notice of opposition and preparing a counterstatement: £400

Preparing written submissions in lieu of a hearing, and commenting
on the opponent's evidence: :

£600

Total: £1000

50. I therefore order Prima Industries Limited to pay 27 Catering Ltd the sum of £1000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 8th day of April 2026

**Suzanne Hitchings
For the Registrar,
the Comptroller-General**